

## **REMARKS/ARGUMENTS**

### ***Amendments in General***

Claim 1 has been amended. Specifically, claim 1 has been amended for purposes of clarity and to specify that the method comprises the steps of adding “past purchasing information”. Support for the amendment can be found in the application as originally found, more specifically in paragraph [0037] of the specification as originally filed. No new matter has been added.

Claim 14 has been amended for clarity. No new matter has been added.

Claim 19 has been amended. Specifically, claim 19 has been amended to include that the demographic information include information about said system user’s age, occupation, personality, children, sex, income level, residence, hobbies, spouse’s shopping habits, wedding anniversaries, the birthdays of relatives, the age of said system user’s children, sex and birthdays, family’s hobbies, political inclinations, and interest in particular advocacy groups, and political parties. Support for the changes can found in the specification in general, and more specifically, paragraph [0037]. No new matter has been added.

### **Standards for Patentability**

“An applicant for a patent is entitled to the patent unless the application fails to meet the requirements established by law. It is the Commissioner’s duty (acting through the examining officials) to determine that all requirements of the Patent Act are met. The burden is on the Commissioner to establish that the applicant is not entitled under the law to a patent . . . . In rejecting an application, factual determinations by the PTO must be based on a preponderance of the evidence, and legal conclusions must be correct.” *In re Oetiker*, 977 F.2d 1443, 1449, 24 USPQ2d 1443, 1447, 24 USPQ2d at 1447 (Fed. Cir. 1992) (Plager, J., concurring).

“The precise language of 35 USC 102 that ‘a person shall be entitled to a patent unless,’ concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103.” *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057, *reh’g denied*, 390 U.S. 1000 (1968).

***Claim Rejections - 35 U.S.C. § 103***

Claims 1, 5, 8–9, and 13

Claims 1, 5, 8–9, and 13 were rejected by the Examiner under 35 U.S.C. § 103 as being obvious over Robertson (6,609,106) in view of Hsu (7,013,292).

The Examiner contends that combining the claims of Robertson with the teachings of Hsu would make obvious all the limitations of claims 1, 5, 8–9, and 13. However, the combination of Robertson and Hsu fail to teach the limitation of matching offers according to user profile information. Both Hsu and Robertson are online gift registries that allow for cross-merchant cooperation for satisfaction of a gift recipient's expressed desires. Their matching systems are determined by matching expressed desires from a gift recipient with those wanting to purchase items for the gift recipient. More specifically, Robertson is a collective registry that allows the gift recipient to register for multiple occasions from multiple merchants. Purchasers select from the field defined by the gift recipient. Purchasers are not involved in defining the field of offers by the merchants but are instead required to select from the field defined by the gift recipient. Secondary active participants are those merchants whose cooperation allows active participants to browse and select items from the merchants and choose to merge the information regarding the active participant's expressed desire into a single interface. Hsu is also a collective registry that allows an active participant to register for multiple occasions from multiple merchants but additionally allows the passive participants to partially pay for goods or services that are expressly desired by an active participant. In either case, the *gift recipient* defines the offers, the purchaser examines chooses from within the list defined by the gift recipient, and the purchaser purchases items based on the expressed desires of the gift recipient.

The current application is a system for creating a field of offers from cross merchant cooperation directed towards a purchaser. The field of offers given to the active participant is defined by system profile information of the system user. It is not defined by the expressed desires of the gift recipient. Merchants that provide the goods and services to the recipients of the goods and services and categorize their goods and services according to a predetermined criteria. The expressed desires of the gift recipients do not define the list of offers offered to the purchaser of goods nor are the list of offers to the purchaser dependent upon the gift recipient finding the goods and services that they want. In this case, the field of offers to the purchaser requires that gift recipient select goods for purchase.

The current application provides a list of offers to the purchaser based on matching the demographic information of a purchaser to predetermined criteria. In this fashion, a smaller list of offers is provided to the user (i.e. purchaser) that is tailored to the purchaser. Neither Robertson nor Hsu match the demographic information of a purchaser to merchant supplied

selection criteria to create a list of offers to a purchaser. Examiner specifically cites Robertson for “matching the organized product offers and information to the organized system user profile information according to a designated criteria” (Office Action, page 3 paragraph 1, citing Robertson, Col. 18, Lines 34-55). Robertson instead teaches an “invention (that) provides a system for registering items *selected by a registrant* from a plurality of participating merchants for subsequent communication to a prospective purchaser.” (emphasis added, Robertson col 2 lines 14-17). A purchaser may “find the appropriate registered user...(by) submitting (a) query (and) if there are no *gift recipients* that match the selected criteria then the No Gift Registrants Found Page... is displayed”. (emphasis added, Robertson col 18 line 39-43).. In Robertson, the offers to the purchaser are already defined by the registrants (i.e. gift recipient) “Wish List”; the demographic information provides an alternative means to locate a registrant. In the present application, the user profile information is used in order to create a list of offers by matching the user profile information to product information. Both Robertson and Hsu fail to teach matching offers by using system profile information and therefore do not teach all of the limitations of claim 1. Thus, while this application matches “organized product offers and information to said system user profile information according to designated criteria,” Robertson and Hsu match product offers to a gift recipients criteria. Accordingly, the limitations of claims 5, 8-9, and 13, which are dependent upon claim 1, are not taught by the combination of Robertson and Hsu.

#### Claims 2, 4, 6-7, and 12

Claims 2, 4, 6-7, and 12 were rejected by the Examiner as being unpatentable over Robertson, Hsu, and in further view of Falls (5,991,771). As discussed previously, the limitations of claim 1, from which claims 2, 4, 6-7 and 12 depend, are not taught by the teachings of Hsu and Robertson in view of Falls. For the foregoing reasons, all of the limitations of Claims 2, 4, 6-7, and 12 are not taught by the combination of Robertson and Hsu.

#### Claim 3

Claim 3 was rejected by Examiner as being unpatentable over Robertson, Hsu, in further view of Woolston (6,202,051). As discussed previously, the limitations of claim 1, from which claim 3 is dependant, and therefore the limitations of claim 3 are not taught by Robertson and Hsu in further view of Woolston. For the foregoing reasons, claim 3 is not obvious in view of the combination of Robertson and Hsu in further view of Woolston.

### Claims 10–12

Claims 10–12 were rejected by Examiner as being unpatentable over Robertson, Hsu, and in further view of Falls.

As discussed previously, the limitations of claim 1, from which claims 10–12 depend, are not taught by the combination of Robertson and Hsu in further view of Falls. For the foregoing reasons, the combination of Robertson and Hsu do not teach the art as claimed by claims 10–12.

### Claims 14–18

Claims 14–18 were rejected by Examiner as being upatentable over Robertson in view of Slotznick and in further in view of Falls.

Slotznick characterizes a system for creating a self learning assistant module that **automatically** initiates transactions for the primary participant, thereby becoming a participant in the selection process. The system learns from transactions, with each future transaction dependant on analysis of those transactions occurring in the past. The system for “executing tasks” (Slotznick, col 23, line 44) is different than a system for creating offers based on system user profile information. Accordingly, claims 14–18 are not obvious in light of the Robertson, Sloznick, and Falls.

### Claim 19

Claim 19 was rejected by Examiner as being upatentable over Robertson in view of the article “Reminder/Gifted Solutions Announces Merchants and Portal Partners Using its New Gift Services Engine at Internet Commerce Expo this Week” in further view of Falls and Woolston.

Claim 19 has been amended to include the limitations that the demographic information consists of information from the user regarding age, occupation, personality, children, sex, income level, residence, hobbies, spouse’s shopping habits, wedding anniversaries, the birthdays of relatives, the age of said system user’s children, sex and birthdays, family’s hobbies, political inclinations, and interest in particular advocacy groups, and political parties. Support for the amendment can be found in the specification in general and more specifically in paragraph [0037] as originally filed. Reminder/Gifted fails to teach a system that matches offers to according to information regarding a system user’s age, occupation, personality, children, sex, income level, residence, hobbies, spouse’s shopping habits, wedding anniversaries, the birthdays of relatives, the age of said system user’s children, sex and birthdays of said system user’s children, family’s hobbies, political inclinations, and interest in particular advocacy groups, and

political parties. Accordingly, the combination of Robertson, in view Reminder/Gifted does not teach all of the limitations of claim 19.

***Conclusion***

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below.

Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 7<sup>th</sup> day of March, 2008.

Very respectfully,

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**CERTIFICATE OF MAILING**

I HEREBY CERTIFY that this correspondence is being electronically deposited with the United States Patent Office via the EFS-Web on the below date as addressed to:

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